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EXAMINER	
SINGH, SATWANT K	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/635,437	WIECHERS, ALEJANDRO	
	Examiner	Art Unit	
	Satwant K. Singh	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *08/07/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-17 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-17 of copending Application No. 10/635,473. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-17 of the instant application are directed towards packaging of a printed document in accordance with the packaging instructions, whereas claims 1-17 of the referenced copending application are directed towards shipping of a printed document in accordance with the shipping instructions. It appears to the examiner that these limitations (packaging in view of shipping) are obvious variations of each other since documents need to be packaged before they can be shipped. Therefore, the print provider needs to know how

the document to be shipped is to be packaged. The packaging instructions are an obvious predecessor to the shipping instructions.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 9-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 9-16, while defining a program product, does not define that the program is embodied on a "computer-readable medium". The claimed program is in itself not a physical product and is therefore non-statutory. The examiner suggests amending the claim to embody the program on "computer-readable medium" in order to make the claim statutory.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 9, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Stewart et al. (US 6,714,964).

5. Regarding Claim 1, Stewart et al disclose a method of performing automated packaging in a commercial printing environment including a designer location (client side of the network 300a) and a print service provider location (printer side 300c), said method comprising: creating a production ready file at the designer location (Fig. 7, S600-640) (user creates a document in a local application, creates a PDF file which is combined with the finishing and binding options to create a print ready file) (col. 8, lines 45-67, col. 9, lines 1-4) using updated device configuration information from the print service provider location (print driver selected by the user is verified) (col. 7, lines 42-67), said production ready file including packaging instructions (PDF file which is combined with the finishing and binding options to create a print ready file) (col. 8, lines 45-67, col. 9, lines 1-4); submitting said production ready file to the print service provider location via an electronic network (print ready file is sent to the print queue and transferred to the production facility) (col. 8, lines 45-67, col. 9, lines 1-4); and receiving a printed output of said production ready file (Fig. 7C, S660, job is ripped and sent through the printer) and packaging said printed output at a packaging device in accordance with packaging instructions from said production ready file (Fig. 7C, S670, printed document is shrink wrapped and packaged) (col. 8, lines 45-67, col. 9, lines 1-4).

6. Regarding Claim 9, Stewart et al disclose a program product for performing automated packaging in a commercial printing environment including a designer location (client side of the network 300a) and a print service provider location (printer side 300c), said product comprising machine-readable program code for causing, when

executed, a machine to perform the following method steps: creating a production ready file at the designer location (Fig. 7, S600-640) (user creates a document in a local application, creates a PDF file which is combined with the finishing and binding options to create a print ready file) (col. 8, lines 45-67, col. 9, lines 1-4) using updated device configuration information from the print service provider location (print driver selected by the user is verified) (col. 7, lines 42-67), said production ready file including packaging instructions (PDF file which is combined with the finishing and binding options to create a print ready file) (col. 8, lines 45-67, col. 9, lines 1-4); submitting said production ready file to the print service provider location via an electronic network (print ready file is sent to the print queue and transferred to the production facility) (col. 8, lines 45-67, col. 9, lines 1-4); and receiving a printed output of said production ready file (Fig. 7C, S660, job is ripped and sent through the printer) and packaging said printed output at a packaging device in accordance with packaging instructions from said production ready file (Fig. 7C, S670, printed document is shrink wrapped and packaged) (col. 8, lines 45-67, col. 9, lines 1-4).

7. Regarding Claim 17, Stewart et al disclose a system of performing automated packaging in a commercial printing environment including a designer location (client side of the network 300a) and a print service provider location (printer side 300c), said method comprising: means for creating a production ready file at the designer location (Fig. 7, S600-640) (user creates a document in a local application, creates a PDF file which is combined with the finishing and binding options to create a print ready file) (col. 8, lines 45-67, col. 9, lines 1-4) using updated device configuration information from the

print service provider location (print driver selected by the user is verified) (col. 7, lines 42-67), said production ready file including packaging instructions (PDF file which is combined with the finishing and binding options to create a print ready file) (col. 8, lines 45-67, col. 9, lines 1-4); means for submitting said production ready file to the print service provider location via an electronic network (print ready file is sent to the print queue and transferred to the production facility) (col. 8, lines 45-67, col. 9, lines 1-4); and means for receiving a printed output of said production ready file (Fig. 7C, S660, job is ripped and sent through the printer) and packaging said printed output at a packaging device in accordance with packaging instructions from said production ready file (Fig. 7C, S670, printed document is shrink wrapped and packaged) (col. 8, lines 45-67, col. 9, lines 1-4).

8.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 2-8, and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart et al. (US 6,714,964) in view of Hansen et al. (US 6,407,820).

11. Regarding Claim 2, Stewart et al teach a method of performing automated packaging, wherein after said step of submitting, said method further comprises a step

of verifying, at said print service provider location, that said production ready file will be produced at said print service provider location as designed at the designer location (document configuration information is validated) (Fig. 7, SD655) (a printer operator selects a job and queues it to an available printer) (col. 8, lines 45-67, col. 9, lines 1-4)

Stewart et al fail to teach a method, correcting said production ready file, including said packaging instructions, to ensure production substantially as designed.

Hansen et al teach a method, correcting said production ready file, including said packaging instructions, to ensure production substantially as designed (policy set to always satisfy the capability request) (col. 19, lines 8-26).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Stewart with the teaching of Hansen to route pages of a print job to a printer that satisfies the capability request.

12. Regarding Claim 3, Stewart et al teach a method of performing automated packaging, wherein said step of correcting further comprises reading packaging instructions prepared at the designer location and preparing appropriate corresponding instructions for an actual packaging device to be used at the print service provider location (Fig. 7, S600-640) (finishing and binding options to create a print ready file) (col. 8, lines 45-67, col. 9, lines 1-4).

13. Regarding Claim 4, Stewart et al teach a method of performing automated packaging, wherein said step of correcting further comprises adding packaging instructions for an actual packaging device to be used at the print service provider location to supplement packaging instructions prepared at the designer location (Fig. 7,

S600-640) (finishing and binding options to create a print ready file) (col. 8, lines 45-67, col. 9, lines 1-4).

14. Regarding Claim 5, Stewart et al fail to teach a method of performing automated packaging, wherein said method further comprises sending an indication of the operational status of the packaging device to a server computer at said print service provider location.

Hansen et al teach a method, wherein said method further comprises sending an indication of the operational status of the packaging device to a server computer at said print service provider location (visual representation of the print server or output device to provide visual feedback of each of the devices status to the user such as the current job queues) (col. 12, lines 62-67, col. 13, lines 1-10).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Stewart with the teaching of Hansen to provide notification about the status of the finishing device to the users so that they can track the status of the document.

15. Regarding Claim 6, Stewart et al fail to teach a method of performing automated packaging, wherein said method further comprises sending an indication of the job completion status of the packaging device to a server computer at said print service provider location.

Hansen et al teach a method, wherein said method further comprises sending an indication of the job completion status of the packaging device to a server computer at said print service provider location (visual representation of the print server or output

device to provide visual feedback of each of the devices status to the user such as the current job queues) (col. 12, lines 62-67, col. 13, lines 1-10).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Stewart with the teaching of Hansen to provide notification about the status of the finishing device to the users so that they can track the status of the document.

16. Regarding Claim 7, Stewart et al teach a method of performing automated packaging, wherein said step of correcting further comprising updating a job ticket corresponding to said production ready file (Fig. 7B, S650 and Fig. 7C, S655, print ready file is transferred to the production facility and queued to an available printer) (col. 8, lines 62-67, col. 9, lines 1-4).

17. Regarding Claim 8, Stewart et al fail to teach a method of performing automated packaging, wherein said step of creating a production ready file at the designer location using updated device configuration information from the print service provider location further comprises selecting an available packaging device based on said updated device configuration information.

Hansen et al teach a method of performing automated packaging, wherein said step of creating a production ready file at the designer location using updated device configuration information from the print service provider location (enhancements and updates incorporated into the desktop) (col. 13, lines 20-49) further comprises selecting an available packaging device based on said updated device configuration information (documents or compound documents can be sent to a production output device by

selecting, clicking or dragging the visual representation of the document or compound document to a visual representation of the print server or output device) (col. 8, lines 62-67, col. 9, lines 1-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Stewart with the teaching of Hansen to provide the user with the latest updated packaging information in preparing the printed document.

18. Regarding Claim 10, Stewart et al teach a program product, wherein after said step of submitting, said method further comprises a step of verifying, at said print service provider location, that said production ready file will be produced at said print service provider location as designed at the designer location (document configuration information is validated) (Fig. 7, SD655) (a printer operator selects a job and queues it to an available printer) (col. 8, lines 45-67, col. 9, lines 1-4)

Stewart et al fail to teach a program product, correcting said production ready file, including said packaging instructions, to ensure production substantially as designed.

Hansen et al teach a program product, correcting said production ready file, including said packaging instructions, to ensure production substantially as designed (policy set to always satisfy the capability request) (col. 19, lines 8-26).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Stewart with the teaching of Hansen to route pages of a print job to a printer that satisfies the capability request.

19. Regarding Claim 11, Stewart et al teach a program product, wherein said step of correcting further comprises reading packaging instructions prepared at the designer location and preparing appropriate corresponding instructions for an actual packaging device to be used at the print service provider location (Fig. 7, S600-640) (finishing and binding options to create a print ready file) (col. 8, lines 45-67, col. 9, lines 1-4).

20. Regarding Claim 12, Stewart et al teach a program product, wherein said step of correcting further comprises adding packaging instructions for an actual packaging device to be used at the print service provider location to supplement packaging instructions prepared at the designer location (Fig. 7, S600-640) (finishing and binding options to create a print ready file) (col. 8, lines 45-67, col. 9, lines 1-4).

21. Regarding Claim 13, Stewart et al fail to teach a program product, wherein said method further comprises sending an indication of the operational status of the packaging device to a server computer at said print service provider location.

Hansen et al teach a program product, wherein said method further comprises sending an indication of the operational status of the packaging device to a server computer at said print service provider location (visual representation of the print server or output device to provide visual feedback of each of the devices status to the user such as the current job queues) (col. 12, lines 62-67, col. 13, lines 1-10).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Stewart with the teaching of Hansen to provide notification about the status of the finishing device to the users so that they can track the status of the document.

22. Regarding Claim 14, Stewart et al fail to teach a program product, wherein said method further comprises sending an indication of the job completion status of the packaging device to a server computer at said print service provider location.

Hansen et al teach a program product, wherein said method further comprises sending an indication of the job completion status of the packaging device to a server computer at said print service provider location (visual representation of the print server or output device to provide visual feedback of each of the devices status to the user such as the current job queues) (col. 12, lines 62-67, col. 13, lines 1-10).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Stewart with the teaching of Hansen to provide notification about the status of the finishing device to the users so that they can track the status of the document.

23. Regarding Claim 15, Stewart et al teach a program product, wherein said step of correcting further comprising updating a job ticket corresponding to said production ready file (Fig. 7B, S650 and Fig. 7C, S655, print ready file is transferred to the production facility and queued to an available printer) (col. 8, lines 62-67, col. 9, lines 1-4).

24. Regarding Claim 16, Stewart et al fail to teach a program product, wherein said step of creating a production ready file at the designer location using updated device configuration information from the print service provider location further comprises selecting an available packaging device based on said updated device configuration information.

Hansen et al teach a program product, wherein said step of creating a production ready file at the designer location using updated device configuration information from the print service provider location (enhancements and updates incorporated into the desktop) (col. 13, lines 20-49) further comprises selecting an available packaging device based on said updated device configuration information (documents or compound documents can be sent to a production output device by selecting, clicking or dragging the visual representation of the document or compound document to a visual representation of the print server or output device) (col. 8, lines 62-67, col. 9, lines 1-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Stewart with the teaching of Hansen to provide the user with the latest updated packaging information in preparing the printed document.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Laverty et al. (US 6,381,032) discloses an on-line automated printing system for quickly producing printed materials.

Hansen et al. (US 6,411,314) discloses a system and method for managing production printing workflow.

Laverty et al. (US 6,903,839) discloses an apparatus for producing normalized graphic image files that have a consistent file structure, the graphic image files thereafter being used to produce a consistent print ready file structure.

Stewart et al. (US 7,095,519) discloses a system and method to upload and recover print jobs over a network.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (571) 272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Satwant Singh
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